

REMARKS

Claims 1-10 and 12-15 were pending in the present application.

By this Amendment, claims 1-10 and 12-15 have been canceled.

New claims 21-40 have been added to conform the claims to the embodiments of the invention, which are disclosed in the specification.

Support for new claim 21 appears in the original claims and the specification on, e.g., page 35, Example 4, page 37, Example 6 and FIG. 9. The specification on page 35, lines 10-18, describes ionic Au was used to prepare the gold nanoparticle. Thus, no Fe atom but only Au was present in the gold nanoparticle. Unlike the superparamagnetic material, iron (Fe), the gold nanoparticle has no magnetic property. The Examiner in the April 10, 2009 Advisory Action has acknowledged that the March 31, 2009 amendment to recite the phrase "contains no Fe atom and has no magnetic property" has support at [0058-0059] of the PGPU.

Support for new claim 22 and 35 appears in the specification on, e.g., page 17, lines 20-25. Support for new claims 23 and 38 appears in the specification on, e.g., page 20, lines 8-14. Support for new claims 24, 25 and 37 appears in the specification on, e.g., page 37, Example 6. Support for new claims 26, 32 and 36 appears in the specification on, e.g., page 39, Example 8. Support for new claims 27-30 and 39-40 appears in the specification on, e.g., page 27, Example 11. Support for new claim 31 appears in the specification on, e.g., page 13, lines 1-10 and FIG. 7, which illustrates the oligosaccharide Pk antigen, an oligosaccharide composed of 3 monosaccharides. Support for new claim 34 appears in the specification on, e.g., page 13, lines 7-20.

No new matter has been added. Applicant respectfully requests that the amendments be entered.

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Applicant appreciates the Examiner's time and guidance given to Applicant's undersigned representative during the March 31, 2009 telephone interview.

The following remarks herein are considered to be responsive thereto.

Claim Rejections – 35 U.S.C. §103

Claims 1-10 and 12-15 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Andres et al. (US 7186398).

The rejections over claims 1-10 and 12-15 are moot due to cancellations of these claims.

Accordingly, Applicant respectfully requests that the § 103 rejections be withdrawn.

New claims 21-40

New claims 21-40 are novel and nonobvious over Andres et al.

The new claims each require “a core gold nanoparticle, comprising gold atoms, **without Fe atoms and having no magnetic property.**”

Andres et al. teach Fe/Au nanoparticle that is **superparamagnetic with a large magnetic susceptibility**. *See* Abstract. The Fe atom concentration is in the range of 5 atom % to 50 atom %, i.e., a range of Fe(5)/Au(95) to Fe(50)/Au(50). Colum 4, lines 53-56. Andres et al. **expressly and specifically teach the Fe content of the nanoparticles is preferably at least**

0.01 atom %; more preferably at least 5 atom %; preferably at most 70 atom % ; more preferably at most 50 atom %, i.e., Fe(50)/Au(50)..

The cited art does not teach the invention because Andres et al. does not teach any nanoparticle that contains no Fe atom and has no magnetic property.

Andres et al. does not provide any suggestion or motivation to make the claimed invention. There is no motivation to replace the Andres' Fe/Au nanoparticle with Fe atom-free Au nanoparticle because doing so would render the prior art inoperable since the purpose of Andres' invention is for bio-magnetic applications.

In the January 23, 2009 Office Action, the Examiner alleged that Andres' Fe/Au nanoparticle "can have as little as 0.01% iron and 99.99% gold" and that "such nanoparticles are essentially pure gold of 99.99% quality."

Applicant respectfully submits that according to the Examiner's stretched imaginations, Andres' Fe(0.01)/Au(99.99) nanoparticles, although 99.99% gold quality, would have little magnetic susceptibility, which would frustrate the very purpose of their invention, i.e., making a magnetic particle for bio-magnetic applications.

It would be extremely unthinkable that one of ordinary skilled in the art at the time when the invention was filed would have been motivated by Andres et al. to make a gold nanoparticle that contains no Fe atom and has no magnetic property for bio-magnetic applications.

No fee is due because Applicants paid the filing fee for 7 independent claims and 49 total claims, and as set forth above, per this Amendment, there are 49 claims pending including 7 independent claims.

Any amendments to the claims not specifically referred to herein as being included for the purpose of distinguishing the claims from cited references are included for the purpose of clarification, consistence and/or grammatical correction only.

It is thus believed that the application is in condition for allowance at least for the above reasons and such allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the foregoing Amendment and Response place this application in condition for allowance. If the Examiner believes that there are any issues that can be resolved by a telephone conference to facilitate the prosecution of this application, or that there are any informalities that can be corrected by an Examiner's amendment, please call the undersigned at 650-557-4464.

Respectfully submitted,

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